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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,581	03/18/1999	ANIL V. RAO	M-7266US	4342

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EXAMINER	
LANIER, BENJAMIN E	
ART UNIT	**PAPER NUMBER**
2132	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/271,581	RAO ET AL.	
	Examiner	Art Unit	
	Benjamin E Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2005* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 December 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 26 October 2005 amends claims 1, 10, 18, 20, 22, and 23, and adds claims 24-28. Applicant's amendment has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 26 October 2005 have been fully considered but they are not persuasive. Applicant's arguments that the prior art does not disclose software being installed is after sale software provided by a computer system manufacturer after the sale of a computer system and that the deciphering of data is to ensure that the after sale software provided by the computer system manufacturer after sale of the computer system is installed only on a computer system manufactured by the computer system manufacturer is not persuasive because it would be an inherent feature of this combination to have the installation procedure of the above combination occur after the sale of the computer system because Kubota discloses that the identification information/key is hardcoded in the microprocessor or implemented in BIOS information at the time of manufacture. Therefore, the software installation procedure disclosed in Kubota would occur after the computer system has been sold. If the software were to be installed before the sale of the computer system, the software would have been installed at the time of manufacture along with the hardcoding of the identification information/key in the microprocessor or implementation in BIOS information. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the computer software that is installed in the copy protection system of the combination disclosed by The Board because the manufacturer of the computer systems would keep their identification/keying information secret

and would therefore themselves encrypt the software to be distributed to their computer systems for installation. Keeping their identification/keying information secret would help prevent users of the manufacturer's computer systems from mistakenly installing computer software provided by other manufacturers.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 4, 5, 8, 10, 12, 13, 16, 18, 20, 22, 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541. Referring to claims 1, 10, 18, 20, 22, and 23, The Board of Patent Appeals and Interferences rejected the claims in the decision mailed out on 30 August 2005. From the decision:

> As discussed above, Kubota teaches the storage of information/key associated with a microprocessor which identifies the microprocessor and is used to decrypt encrypted software for use only by that microprocessor with a specific prestored key. We find this

teaching to be a teaching of storing identification which would identify the manufacturer of the microprocessor. Similarly, we find this teaching of storing specific identification of the microprocessor akin to a Vehicle Identification Number NIN) on an automobile. Furthermore, we find the specific identification of the manufacturer of the microprocessor to readily suggest that any manufacturer information for any other components of the system or the overall system may be stored so as to limit the use of various software programs and other system modifications as disclosed and suggested by Kubota. (Kubota at column 3, lines 16-31.) Furthermore, we find that Kubota suggests the duplication of cipher codes for certain groups of computers when all will be used at the same location, such as, a school so that a group license for software may be used for all the computers in a classroom. (Kubota at col. 6, line 66-coI. 7, line 5.)
With Kubota's specific suggestion that the identification information is typically used in the personal computer, we find this teaching to suggest that any application using a microprocessor could similarly code manufacturer information into the system. This code could either be hardcoded in the microprocessor at the time of manufacture or in the software which is used at the time of boot up, such as, in the BIOS. Most computers and components therein have identification information stored and used during the boot up of the computer. Therefore, we find that the teachings of Kubota teach or fairly suggest all of the claimed limitations but for the storage of the encryption key information in a configuration file and searching therein for the key.
As evidence of the well known use of the a configuration file or registry file in a Microsoft Windows Operating System, we rely upon the teachings of Patterson which clearly set forth the ordinary operation in the Windows system. Therefore, we find this to be a compelling suggestion of the location for the storage of encryption/decryption information which would also identify the manufacturer of the computer system. (Patterson at col. 3, lines 37-63.)
Appellants argue that providing manufacturer specific identification information identifying a computer system manufacturer is "patentably distinct from uniquely identifying a particular microprocessor as disclosed by Kubota." (Brief at page 8.) Appellants further argue that neither Kubota nor Patterson provides a disclosure relating to providing manufacturer specific information identifying a computer system manufacturer. (Brief at page 8.) While we agree with appellants that there is no express teaching concerning the overall computer system manufacturer, we find express suggestions in the disclosure of Kubota that modifications are within the level of skill in the art and we find express teachings of the incorporation of the microprocessors into computer systems and the plural computers/microprocessors can be coded similarly so as to allow group licenses for software. We find these extensions of the teachings of Kubota to suggest providing manufacturer specific information identifying a computer system manufacturer.

6. With respect to the combination made by the Board above, it would be an inherent feature of this combination to have the installation procedure of the above combination occur

after the sale of the computer system because Kubota discloses that the identification information/key is hardcoded in the microprocessor or implemented in BIOS information at the time of manufacture. Therefore, the software installation procedure disclosed in Kubota would occur after the computer system has been sold. If the software were to be installed before the sale of the computer system, the software would have been installed at the time of manufacture along with the hardcoding of the identification information/key in the microprocessor or implementation in BIOS information. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the computer software that is installed in the copy protection system of the combination disclosed by The Board because the manufacturer of the computer systems would keep their identification/keying information secret and would therefore themselves encrypt the software to be distributed to their computer systems for installation. Keeping their identification/keying information secret would help prevent users of the manufacturer's computer systems from mistakenly installing computer software provided by other manufacturers.

Referring to claims 5, 13, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code during its manufacture. A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor can decipher it (Abstract, Col. 2, lines 1-45). Microprocessor also has means to store software information on floppy disks and hard disks (Col. 1, lines 15-63), which meets the limitation of copying the deciphered data onto another nonvolatile storage device connected to the computer system.

Referring to claims 24-28, Kubota discloses that the user must obtain a special program to perform the decryption and installation procedures (Col. 2, lines 19-32), which meets the limitation of the reading, determining and deciphering are performed by a setup program.

Referring to claims 4, 8, 12, 16, Kubota discloses a system for providing copy protection wherein a microprocessor is encrypted with a unique code (configuration file) during its manufacture (manufactured by a computer system manufacturer, identifying the computer system manufacturer). A software package is encrypted to function uniquely with a particular microprocessor such that only the unique cryptographic code in the microprocessor (identification information) can decipher it (read configuration file, ensure that the software is installed only on a computer system manufactured by the computer system manufacturer)(Abstract, Col. 2, lines 1-45). Microprocessor also has means to store software information on floppy disks and hard disks (non-volatile storage)(Col. 1, lines 15-63). Kubota does not disclose storing the key in a registry file that is stored on a nonvolatile storage device. Patterson discloses a system to regulate access to digital content where on the Windows Operating System a registry file is used to store the unique coded key (Col. 3, lines 54-56), and the use of CD-ROM (Col. 3, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the key taken from the configuration file in Kubota in a registry file in order to lock the installed object to that particular machine as taught in Patterson (Col. 3, lines 56-63).

7. Claims 2, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541, as applied to claim 1, 10 and in view of Charabaszcz, U.S. Patent No. 6,363,497. Referring to claims 2, 11, in addition to

the teachings above, Kubota does not disclose a BIOS memory file included in the configuration file. Charabaszcz discloses a primary server that calls a backup server to read the BIOS or configuration files when the primary server goes down (Col. 12, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a BIOS memory file with the configuration file of Kubota in order to have both the BIOS file and configuration file information together for system reset purposes as taught in Charabaszcz (Col. 12, lines 61-65).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541, in view of Charabaszcz, U.S. Patent No. 6,363,497 as applied to claim 2 above, and further in view of Dollahite, U.S. Patent No. 5,748,877. Referring to claim 3, in addition to the teachings above, Charabaszcz does not disclose a BIOS memory file stored on a nonvolatile memory. Dollahite discloses a BIOS memory file stored on an electrically erasable programmable read-only memory (EEPROM) (Col. 3, lines 3-9), which by definition is nonvolatile. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a BIOS memory file stored on an EEPROM in the technique for mass distribution of software of Kubota in order to save the state of the PC to a hard disk for resetting purposes as taught in Dollahite (Col. 1, line 63- Co. 2, line 5).

9. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541, as applied to claims 1, 10 and further in view of Cooper, U.S. Patent No. 5,757,904. Referring to claims 6 and 14, in addition to the teachings above, Kubota does not disclose checking the authenticity of the key

taken from the configuration file. Cooper discloses a method for providing distributed software where the decryption key provided by the software vendor is authenticated (Col. 15, lines 42-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to authenticate the key used in the technique for mass distribution of software of Kubota in order to inform the user-controlled system that the key taken from the configuration file is authentic as taught in Cooper (Col. 15, lines 54-60).

10. Claims 7 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541, as applied to claims 1, 10 and further in view of Pearce, U.S. Patent No. 5,694,582. Referring to claims 7 and 15, in addition to the teachings above, Kubota does not disclose the reading and determining program being stored in a dynamic linked library. Pearce discloses an operating system that loads an executable file for execution and replaces references with addresses that are valid for usage in function calls. A dynamic link library is a module that satisfies these references by dynamic linking (Col. 5, lines 10-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the program that reads the configuration file and determines the key to be stored in a dynamic linked library in order to provide runtime support code that is linked to an executable file as taught in Pearce (Col. 5, lines 3-5).

11. Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541, as applied to claims 1, 10, and further in view of Saxena, U.S. Patent No. 6,259,449. Referring to claims 9 and 17, in addition to the teachings above, Kubota does not disclose storing data on a Web Page accessible to a global computer network. Saxena discloses a web server that stores data in the form of web

pages and transmits these pages as Hypertext Markup Language (HTML) files over the Internet network to a host computer (Col. 3, lines 37-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store data from the nonvolatile storage devices in Kubota as web pages so that the data is accessible over the Internet through a web browser as taught in Saxena (Col. 3, lines 41-46).

12. Claims 19 and 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota, U.S. Patent No. 5,034,980, in view of Patterson, U.S. Patent No. 6,389,541 as applied to claims 18 and 20 above, and further in view of Charabaszcz, U.S. Patent No. 6,363,497. Referring to claims 19 and 21, in addition to the teachings above, Patterson does not disclose a BIOS memory file included in the configuration file. Charabaszcz discloses a primary server that calls a backup server to read the BIOS or configuration files when the primary server goes down (Col. 12, lines 57-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a BIOS memory file with the configuration file of Kubota in order to have both the BIOS file and configuration file information together for system reset purposes as taught in Charabaszcz (Col. 12, lines 61-65).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin E. Lanier

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